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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,843	02/13/2002	Jotham Wadsworth Coe	PC10030C	9975

7590

08/26/2004

Paul H. Ginsburg
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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/075,843	Applicant(s) COE ET AL.	
	Examiner Brenda Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10 and 15-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-6,8-10 and 17-23 is/are allowed.
- 6) ☒ Claim(s) 7,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 4-10 and 15-23 are pending in the application.

This action is in response to applicants' amendment filed June 23, 2004.

Claim 1 has been amended.

Response to Arguments

Applicants' arguments filed June 23, 2004 have been fully considered with the following effect:

1. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection of claims 15 and 16, labeled paragraph 2) in the last office, which are hereby **withdrawn**.
2. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled 3a) and 3c) in the last office, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejection labeled 3b), the applicants' amendments and remarks have been fully considered but they are not found persuasive.

b) The applicants' state that claim 7 refers to a specific pharmaceutical composition requiring a specific quantity of a compound according to claim 1 to produce a specific result and that claim 9 differs substantially from claim 7 because it recites a general pharmaceutical composition and does not specify that the quantity of a compound according to claim 1 present in the composition be effective in producing a specific result. The recitation of an intended use, chemical activity or

functional description of some "additional" property for a compound or a composition containing same in a dependent claim, must result in a tangible structural difference between the product of the independent claim and that of the dependent claim, said dependent claim is seen to be a substantial duplicate, and said recitation is not afforded critical weight and fails to further limit the product in the said dependent claim.

Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

3. The applicants' arguments are sufficient to overcome the obviousness-type double patenting rejection of claims 7-10, labeled paragraphs 4), 5) and 6) in the last office, which are hereby **withdrawn**.

4. The applicants' amendments and arguments are sufficient to overcome the obviousness-type double patenting rejection of claim 1, labeled paragraph 7) in the last office, which is hereby **withdrawn**.

In view of the amendment dated June 23, 2004, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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5. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

a) Claim 15 recites the limitation "2-fluorobenzamide" in the first species. There is insufficient antecedent basis for this limitation in the claim.

b) Claim 16 is vague and indefinite in that it is dependent upon canceled claim 3.

c) Claim 16 recites the limitation "acetamide" in the fourth species. There is insufficient antecedent basis for this limitation in the claim.

Allowable Subject Matter

6. Claims 1, 4-6, 8-10 and 17-23 are allowed. None of the prior art of record or a search in the pertinent art area teaches the compounds, compositions and method of use of the compounds of formula (I) as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Brenda Coleman". The signature is fluid and cursive, with the first name "Brenda" and last name "Coleman" clearly distinguishable.

Brenda Coleman
Primary Examiner Art Unit 1624
August 18, 2004